

without disassembly for loading and unloading of said food product.

33. (Amended) A rotatable food support in combination with a compact smoking oven, comprising:

at least one grate for supporting a food product to be smoked in said compact smoking oven, said grate being rotatably mounted on at least one rod located within said compact oven, said rod having an axis and being rotatable about said axis; said rod being inserted into said grate along a central line of said grate, said grate being rotatable around said axis of said at least one rod, said grate being composed of at least two portions movable between a position in which said portions are located close to one another so as to enclose a food product therebetween, and an open position in which said grate portions are moved apart so as to load or unload said food product.

34. (Amended) A compact smoking oven in accordance with claim 5, wherein said food product supporting means is entirely removable from said compact smoking oven without disassembly for loading and unloading of food product.

#### **Remarks**

Claims 1-29 and 31-34 are currently pending in the application.

Applicant is submitting herein a substitute abstract page containing an amended abstract.

Applicant has cancelled Figs. 23 and 24. For detailed explanation of matters relating to Figs. 18B, 18C, 12A, 13A and 13B, please see below.

#### **New Matter**

Applicant respectfully submits to the Examiner's attention that the objection to the specification and Figs. 12A, 13 A and 13B on the basis that they do not provide support for

Fig. 13B, grate 45  
is secured between  
discs 41 & 42. 142

Claim 32 is not proper, because the specification, and particularly Fig. 13B, shows the grate connected to the discs 41 and 42. As shown in Fig. 13B, the grate 45 is mounted for rotation around the rod 36, which is secured within the removable food support discs 41 and 42.

Additionally, support for Claim 32 may be found in the original Claim 13, which recites : "food product supporting means including a grate ..., two discs rotatable about a horizontal axis ...; and a turnable rod located between said rotatable discs and supporting said grate." Therefore, the new matter objection with respect to Claim 32, specification and Figs.12A, 13A and 13B should be withdrawn.

Applicant has amended Claim 4. Claim 4 now recites in pertinent part: "a sloping tray means." The recited limitation may be found in Figs. 18B and 18C which show a sloping tray 12.

***Rejection based upon recapture of the surrendered subject matter***

Amended claims 1-14 and new claim 34 were rejected by the Examiner under 35 U.S.C. §251 because, according to the Examiner, the subject matter of these claims constitute an improper recapture of the broadened subject matter surrendered during prosecution of the original patent. Applicant respectfully disagrees with the Examiner as described more fully below.

In accordance with the prosecution history of the original '471 patent, the limitation "box-shaped" was present in the original Claim 1 of the patent application which led to the issuance of the '471 patent. More specifically, the original Claim 1 of that patent application stated as follows:

A compact smoking oven, comprising a box-shaped housing

having a peripheral wall composed of two wall portions spaced from one another and including an inner wall portion provided with a plurality of throughgoing openings; a container for accommodating wooden chips and having at least one wall provided with a plurality of openings; means for heating said container so that when said container is heated and wooden chips inside said container are heated, a smoke is produced which exits said container through said openings in said container, then enters a space inside said peripheral wall and exits said space through said openings of said inner wall portion into an interior of the housing; and means for holding a food product to be smoked by said smoke.

As the Examiner properly indicated in the Office Action, the original Claim 1 was cancelled but all of its limitations were included in the added Claims 19, 20, 21, 23, 24, 25, 26, and 27, which were renumbered for issuance as Claims 1, 9, 10, 11, 12, 5, 13, 14, respectively. Therefore, the limitation of "box-shaped" housing was contained within Claims 1, 5, and 9-14 of the original patent from the moment of filing, not from the time of the amendment of the original patent application. Moreover, this limitation was not necessary to distinguish the claimed invention from the prior art of record. Consequently, the elimination of this limitation does not constitute an improper recapture of the surrendered subject matter but, instead, it is a permissible broadening of the scope of the claims specifically authorized by 35 U.S.C. §251. Therefore, Applicant believes that the rejection of Claims 1-14 and 26-34 based upon the alleged recapture of surrendered subject matter is improper and should be withdrawn.

The Examiner indicated in the Office Action that Claims 26-33 may be "treated by a rejection such as not being for the invention disclosed in the original patent ..., as evidenced by the claims in the original patent" citing In re Rowand, 526 F.2d 558, 187 USPQ 487 (CCPA 1975) Applicant respectfully bring to the Examiner's attention that the Court of Appeals for the Federal Circuit explaining the Rowand decision stated in In re Amos, 953 F.2d 613, 618-619, 21

USPQ 2d 1271, 1275 (Fed. Cir. 1991): “Merely finding that the subject matter was ‘not originally claimed, not an object of the original patent, and not depicted in the drawing,’ does not answer the essential inquiry under the ‘original patent’ clause of §251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an ‘intent,’ even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.” It is clear, that (a) the subject matter presented in the amended claims 26-29 and 31-33 is described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. §112 first paragraph is satisfied; and (b) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application. See MPEP 1412.01. Therefore, all possible rejections under 35 U.S.C. §251 enumerated on page 5 second full paragraph are not appropriate with respect to amended Claims 26-29 and 31-33.

Since the Examiner did not present any further objections or rejections of Claims 1-14, and 32 in the Office Action, these claims are deemed allowable.

#### ***Claim Rejections - 35 U.S.C. §112***

The Examiner rejected Claims 14, 29-32 and 34 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, under 35 U.S.C. §112. Applicant has amended Claims 14, 29-32 and 34 to overcome this rejection. With regard to Claim 14, Applicant has eliminated the duplicative language and

apologizes to the Examiner for any possible confusion. With regard to Claim 29, Applicant has accepted the Examiner's suggestion of deleting the limitation of "a compact smoking oven" from line 3 and added a clarifying adjective "detachable" before the word "combination" into the preamble. To overcome another §112 objection to Claim 29, Applicant has substituted the definite article "the" with the indefinite article "a" before the recitation of "axial direction," line 7 of the presently submitted Claim 29 (line 10 of the March 16, 2001 amendment). With respect to Claim 32, Applicant has amended this claim to eliminate the recitation of "a compact smoking oven" from line 3, added a clarifying adjective "detachable" before the word "combination" into the preamble, substituted the definite article "the" with the indefinite article "a" before the recitation of "axial direction," line 7 of the presently submitted Claim 32 (line 11 of the March 16, 2001 amendment), and corrected the spelling of word "grate, as suggested by the Examiner. With respect to Claim 34, Applicant has deleted the word "said" before "food product". Since food product is not an element of the structure, no article is believed to be necessary. With respect to Claim 31, Applicant has amended the Claim to recite "at least two of said rotatable discs." This amendment is believed to eliminate the ground for rejection of Claim 31 under 35 U.S.C. §112.

#### ***Claim Rejections - 35 U.S.C. §102***

The Examiner in the Office Action rejected Claims 26 and 28 under 35 U.S.C. §102(b) as being allegedly anticipated by Riccio (U.S. Patent No. 5,184,540). Applicant has amended Claim 26 to overcome this rejection and to more particularly point out patentable features of the invention. Riccio discloses a cooking apparatus for use with a fireplace. The disclosed cooking apparatus has a drive member 88 rotatably connected to the housing and a plurality of spits 68.

The drive member 88 has a passageway 90 for each spit 68, the passageway is shown in Fig. 3 of the '540 patent. As shown in Fig. 3, the passageway 90 defines at least four driving shoulders and each spit 68 has at least three driven shoulders. The driving shoulders of the passageway engage and rotate the driven shoulders of each spit resulting in the spit rotating more than one complete revolution every time the drive member is rotated one revolution. See Column 2, lines 32-34, and Column 4, lines 20-25, lines 39- 45 and lines 50-54. Contrary to Riccio, Claim 26 now recites "a plurality of circular openings located along a circumference of" both rotatable discs for insertion of food supporting rods. The recited construction of the provided food support results in each rod making only one complete revolution every time the rotatable discs are rotated one revolution. Claim 26 was amended to recite this distinction. The support for this amendment is inherent in the description of the process of rods' rotation in column 4, lines 7-16. As explained, flywheels 44 tending to preserve their vertical position rotate the rods they are positioned on. Therefore, in accordance with the laws of physics, each rod can complete only one complete revolution within its circular opening during one complete revolution of the disc. Based on the above, amended Claim 26 is believed to be patentable over the '540 patent, and the rejection should be withdrawn. Further, Claims 27 and 28 are also patentable over the '540 patent because they are dependent from Claim 26 and therefore recite the same limitations. Moreover, Claims 27 and 28 contain other limitations not taught by the prior art of record.

In the Office Action the Examiner rejected Claims 29 and 31 under 35 U.S.C. §102(b) as being allegedly anticipated by Moreth (U.S. Patent No. 5,373,778) and, additionally, by Kahn (U.S. Patent No. 3,348,545). Applicant has amended Claim 29 to recite all limitations of Claim 30. More particularly, as amended Claim 29 now recites "a grate for supporting said food

product; said grate being removably attached to said at least one rod and said rotatable disc and being configured to rotate together with said disc.” Neither Moreth nor Kahn disclose the invention as now claimed in Claim 29.

The Examiner also rejected Claims 29-31 under 35 U.S.C. §102(b) as being allegedly anticipated by Unruh et al (U.S. Patent No. 5,421,318). As explained above, Applicant has canceled Claim 30 and amended Claim 29 to recite all limitations of canceled Claim 30. Additionally, Claim 29 is now reciting the following limitation: “said at least one rod is inserted into said grate along a central line of said grate, wherein said grate is rotated around said axis of said at least one rod.” This limitation is neither taught nor suggested by Unruh.

The Examiner rejected Claim 33 under 35 U.S.C. §102(b) as being allegedly anticipated by Koziol (U.S. Patent No. 3,566,777). Applicant has amended Claim 33 to overcome this rejection. Claim 33 now recites the limitation of “rod being inserted into said grate along a central line of said grate, said grate being rotatable around said axis of said at least one rod.” The support for this limitation is found in Fig. 16. This limitation is neither taught nor suggested by Koziol.

In view of the above amendments and remarks, it is submitted that all of the claims remaining in the application, specifically claims 1 -14, 26 - 29, and 31-34, are currently in patentable form. A prompt and favorable allowance of all of the claims is requested and believed fully warranted. Should the Examiner have any questions concerning the present Amendment, a telephone call to counsel at (212)756-2167 would be welcomed.

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Respectfully submitted,

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